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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,069	10/23/2001	Kiyohito Ishida	ISHIDA=8A	8892

7590 10/16/2003

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EXAMINER
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IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/983,069

Applicant(s)

ISHIDA ET AL.

Examiner

Sikyin Ip

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: In page 9 of the instant specification, that there are two identical description for Figure 26, paragraphs [0046] and [0047].

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 15-17 of U.S. Patent No. 6406566. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed Cu based

alloy composition, guide wire, and the catheter structure are overlapped by the claims of cited patent.

***Claim Rejections - 35 USC § 103***

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-17 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5769796 to Palermo et al in view of USP 4750953 to Tabei.

7. Palermo in col. 2, lines 16-30 discloses a guidewire having a body portion relatively high in rigidity and a distal portion relatively flexible. The conventional catheter guidewire is tapered along its length to allow great flexibility (Palermo, col.

1, lines 60-67 and col. 5, lines 20-27). The coil could be plated or coated with a malleable or solderable metal such as gold (Palermo, col. 4, lines 6-25 and col. 6, lines 1-15). The guidewire material is selected from stainless steel wire, super-elastic alloy tubing, or braid of a super-elastic alloy ribbon (Palermo, col 4, lines 26-39). The difference between the reference(s) and the claims are as follows: Palermo does not disclose the claimed specific shape memory/super-elastic Cu-Al-Mn alloy and its heat treatment steps. But, the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113. It is the patentability of the product claimed and not of the recited process steps which must be established. See In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972). The guidance that has been provided by court on this matter is

[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

See In re Thorpe, 777 F.2d 695, 227 USPQ 964, 966 (Fed. Cir. 1985). When applicant's and prior art's products are to be identical or substantially identical, the burden shifts to applicant to provide evidence that the prior art product does not inherently possess the claimed properties. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Fessmann, 489 F.2d 742, 745 180 USPQ

324, 326 (CCPA 1974); and In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

8. With respect to the Cu-Al-Mn alloy composition, Tabei discloses the shape memory alloy (col. 1, lines 55-66) and thermal mechanical treatment (col. 3, lines 52-58) in the same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to provide Palermo with shape memory alloy as taught by Tabei for its intended properties. It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

#### *Conclusion*

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant

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should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.


*Examiner Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
\_\_\_\_\_  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
October 1, 2003